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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KELLI HODGE KENNEDY,
GARTH FREDERICK SCHMELING, DARREL DAVID CHERRY, and
ALEXANDER A. MCMAINS

Appeal 2010-003649
Application 09/782,765
Technology Center 3600

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1, 3-7, 9, 10, 12-17, 19, 21, 23-27, and 29-30 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellants' claimed invention is directed to document distribution services for a user's document (Spec. 2-8). Claim 9, reproduced below, is representative of the subject matter of appeal.

9. A computer-readable medium having computer-executable instructions for performing a method of distributing a document of a user, the document including at least one of textural and graphical information, the method comprising:

registering document distribution services of a plurality of document distribution providers, the document distribution services including at least one of print services, electronic mail services, and print publishing services;

receiving a distribution request for the document from the user;

compiling a list of distribution options for the document based on the document distribution services of the document distribution providers; and

presenting the list of distribution options for the document to the user, wherein the user provides the document for distribution.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Straub	US 6,216,141 B1	Apr. 10, 2001
Ta	US 6,931,545 B1	Aug. 16, 2005

The following rejections are before us for review:

1. Claims 1, 3-7, 19, 21, and 23-25 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.
2. Claims 1, 3-7, 9, 10, 12-17, 19, 21, 23-27, and 29-30 are rejected under 35 U.S.C. § 103(a) as unpatentable over Straub and Ta.

DISPOSITION OF THE APPEAL

The Examiner entered a new ground of rejection in the Examiner's Answer against claims 1, 3-7, 19, 21, and 23-25 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter (Ans. 4-5). The Examiner properly gave notice of the new ground of rejection (Answer 4-5) and the Technology Center Director approved it. (Ans. 10). As the Answer indicated (Ans. 10), the Appellants were required to respond to the new ground within two months in either of two ways: 1) reopen prosecution (*see* 37 CFR § 41.39(a)(2)(b)(1)); or 2) maintain the appeal by filing a reply brief as set forth in 37 CFR § 41.41 (*see* 37 CFR § 41.39(a)(2)(b)(2)), "to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection." According to the record before us, neither option appears to have been exercised. Accordingly, the appeal as to claims 1, 3-7, 19, 21, and 23-25 subject to the new ground of rejection under § 101 as

being directed to nonstatutory subject matter stands dismissed. Upon return of the application to the Examiner, the Examiner should (1) cancel claims 1, 3-7, 19, 21, and 23-25 subject to the new ground of rejection and (2) notify the Appellants that the appeal as to claims 1, 3-7, 19, 21, and 23-25 subject to the new ground of rejection under § 101, as being directed to nonstatutory subject matter, is dismissed and claims 1, 3-7, 19, 21, and 23-25 are cancelled. *See* Manual of Patent Examining Procedure (MPEP) § 1207.03, 8th ed., Rev. 7, Jul. 2008. Given that the appeal as to claims 1, 3-7, 19, 21, and 23-25 stands dismissed, the rejections before us for review is reduced to as follows:

1. Claims 9-10, 12-17, 26-27, and 29-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable under 35 U.S.C. § 103(a) as unpatentable over Straub and Ta.

THE ISSUES

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

This issue turns on whether Straub discloses the claim limitations which have been argued by the Appellants.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:²

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

- FF1. Straub has disclosed a system for integrating a document into a desktop window. (Title).
- FF2. Straub at Col. 12:10-15 fails to disclose a document distribution service including one of print services, electronic mail services, and print publishing services.
- FF3. Straub at Col. 3:31-35 and 9:9-22 fails to disclose compiling a list of distribution options for the document and presenting the list of distribution options to the user.
- FF4. Ta has disclosed a system for integrity certification and verification of content consumption environments (Title).

ANALYSIS

The Appellants argue that the rejection of claims 9-10 and 26-27 each recite that: 1) the user provides the document for distribution such that the user is presented with and/or makes a selection of distribution options for the document and 2) that the document distribution services include at least one of print services, electronic mail services, and print publishing services (Br. 8). The Appellants argue that Straub fails to disclose claim limitations for these features (Br. 8-9).

In contrast, the Examiner has determined that Straub discloses the cited claim limitations at Col. 3:31-55, Col. 9:9-22 and Col. 12:10-15. (Supp. Ans. 6-7).

We agree with the Appellants. Claim 9 requires in part claim limitations [1] and [2] listed below:

[1] *document distribution services including at least one of print services, electronic mail services, and print publishing services;*
and

[2] *compiling a list of distribution options for the document based on the document distribution services of the document distribution providers; and presenting the list of distribution options for the document to the user.*

At the portions of the reference cited by the Examiner, Straub fails to disclose document distribution services including one of print services, electronic mail services, and print publishing services (FF2) and also fails to disclose compiling a list of distribution options for the document and presenting the list of distribution options to the user (FF3). Straub at col. 3:31-55 discloses providing document preferences which drive the display of one or more documents related to that preference, but it is not apparent, and the Examiner has not explained, how this disclosure in Straub makes obvious the claim elements [1] and [2]. For these reasons the rejection of claim 9 is not sustained.

Claims 10 and 26-27 contain similar limitations to those addressed above and for the same reasons given above the rejection of these claims and their dependent claims is also not sustained.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 9-10, 12-17, 26-27, and 29-30 under 35 U.S.C. § 103(a) as being unpatentable under 35 U.S.C. § 103(a) as unpatentable over Straub and Ta.

DECISION

The Examiner's rejection of claims 9-10, 12-17, 26-27, and 29-30 is not sustained.

Appeal 2010-003649
Application 09/782,765

REVERSED

JRG

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